

REMARKS/ARGUMENTS

Favorable consideration of this application is respectfully requested.

Claims 1-4 and 8-15 are presently active in this application. Claims 8-15 have been withdrawn from consideration. Claim 1 has been amended based upon the disclosure found at page 16, line 25 through page 17, line 1 and page 21, line 23 through page 22, line 1, for example. Clearly, Claim 1 has been amended without the introduction of any new matter.

The outstanding Action presents a suggestion that domestic priority to parent Application Serial No. 09/931,888, filed 08/20/2001 was not claimed in accordance with CFR §1.78, an indication that Claims 8-15 have been withdrawn from consideration, a rejection of Claims 1 and 2 based upon the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of U.S. Patent No. 6,777,967, a rejection of Claims 1, 3, and 4 based upon the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 3 of U.S. Patent No. 6,777,967, and a rejection of Claims 1-4 as being anticipated by Revirieux (U.S. Patent No. 4,477,774) under 35 U.S.C. §102(b).

Turning to the apparent suggestion at the top of page 2 of the outstanding Action that domestic priority to parent Application Serial No. 09/931,888, filed 08/20/2001 was not properly claimed, it is noted that the Preliminary Amendment filed with this Application on March 18, 2004, included an amendment to the specification that inserted a claim for domestic priority after the title on page 1 of the specification as follows:

This application is a Division of Application Serial No. 09/931,888 filed on 08/20/01.

In addition, the Application as filed included an "APPLICATION DATA SHEET" that also indicated (on page 3 thereof) that Domestic Priority was being claimed in terms of this Application being a Division of 09/931,888, filed 08/20/01.

Accordingly, the requirements of 35 U.S.C. §120 and 37 CFR §1.78 have been complied with and the PTO is respectfully requested to confirm this in the next correspondence sent as to this Application.

Before considering the outstanding rejections applied as to Claims 1-4, a brief review of the subject matter of base independent Claim 1 is believed to be helpful. In this regard, the subject matter of base independent Claim 1 (included in Claims 2-4 by virtue of their dependency from Claim 1) relates to a method of inspecting a target object to be inspected including bringing about a fritting phenomenon using at least one probe in a part of an insulating film formed on an inspection electrode of the target object to be inspected so as to break a part of the insulating film and then stopping a voltage from being applied across the at least one probe and the inspection electrode when a current flowing between the at least one probe and the inspection electrode reaches a reference value. The at least one probe that was used to bring about the fritting phenomenon is then brought into electrical contact with the surface of a part of the inspection electrode cleared of the insulating film by the fritting phenomenon and the electrical characteristics of the target object are inspected by using a tester connected to the at least one probe.

The stopping of the voltage being applied across the at least one probe and the inspection electrode when a current flowing between the at least one probe and the inspection electrode reaches a reference value is advantageous in several respects. For example, it helps protect the tip portion of the at least one probe, the target object, and the contact portion formed by the at least one probe tip portion and the electrode

of the target object from being damaged due to excessive current flow damage that can occur from a current surge when the insulating film is broken. The fritting process time can further be reduced as there is a positive stopping of the fritting voltage due to the presence of a current flow indicating the breaking of the insulating film which permits the changeover to inspection at the earliest possible time.

The rejection of Claims 1 and 2 based upon the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of U.S. Patent No. 6,777,967, a rejection of Claims 1, 3, and 4 based upon the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 3 of U.S. Patent No. 6,777,967 are believed to be no longer applicable as to the presently pending Claims 1-4. This is because Claims 2-4 depend from amended Claim 1 that requires the above noted advantageous step of “stopping a voltage from being applied across the at least one probe and the inspection electrode when a current flowing between the at least one probe and the inspection electrode reaches a reference value” that cannot be said to be reasonably taught or suggested by any of the claims of U.S. Patent No. 6,777,967.

Accordingly, the withdrawal of the rejection of Claims 1 and 2 based upon the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of U.S. Patent No. 6,777,967 and the withdrawal of the rejection of Claims 1, 3, and 4 based upon the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 3 of U.S. Patent No. 6,777,967 are both believed to be in order.

Turning to the rejection of Claims 1-4 as being anticipated by Revirieux, it is noted that this reference does not teach or even suggest all the subject matter recited by amended base independent Claim 1. Note, for example, the requirement of

amended base independent Claim1 for the above-noted advantageous step of
“stopping a voltage from being applied across the at least one probe and the
inspection electrode when a current flowing between the at least one probe and the
inspection electrode reaches a reference value” that cannot be said to be reasonably
taught or suggested by Revirieux.

As Claims 2-4 all ultimately depend from Claim1 and include all the
limitations thereof, the subject matter of these dependent claims also cannot be said to
be reasonably taught or suggested by Revirieux.

Accordingly, the withdrawal of the rejection of Claims 1-4 as being
anticipated by Revirieux is also respectfully submitted to be in order.

As no further issues are believed outstanding in the present application, it is
believed to be clearly in condition for formal allowance. Accordingly, an early and
favorable action to that effect is therefore earnestly and respectfully requested.

Respectfully submitted,

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